

REMARKS

Claims 1, 2, 4-31, 33-59, 61-85, 87-109, and 114-120 are pending and stand rejected. The claims remain pending because no amendments are offered in this reply.

REJECTIONS OVER SETH U.S. PATENT 6,350,471

In the Final Rejection, all of the claims stand rejected on the basis of Seth '471 as primary reference, with various secondary references. If the primary Seth reference is removed as prior art, the secondary references are not sufficient by themselves to maintain the *prima facie* case of obviousness.

As discussed below, the Seth reference is removed as prior art based on a showing by the inventors that the relevant disclosure of the Seth '471 represents their joint work. According to court precedent and the MPEP, such a showing is sufficient to remove the reference under 35 U.S.C. § 102(e). Because of this, Applicants respectfully request that the rejections of all the claims based on the Seth reference be withdrawn.

CONSIDERATION AFTER FINAL REJECTION

Consideration of these remarks after a Final Rejection is proper because they place the claims in an allowable condition and require no further examination. Applicants respectfully request further and favorable consideration. These remarks are directly responsive to concerns raised by the Examiner in the Office Action, as discussed in an interview discussed below.

TELEPHONE INTERVIEWS WITH EXAMINER PERREIRA

Applicants would like to thank Examiner Perreira for the many courtesies extended to Applicants' representative Mark Frentrup in phone calls on July 16, July 17, July 22, and July 24, 2008. On the 16th, Applicants' representative called the Examiner to inquire about the rejection of the Rule 132 Declaration for the reason stated in the Final Rejection. The Examiner explained that the rejection of the Declaration was intended and that the rejection was endorsed by SPE Hartley.

On the 22nd, after consulting with SPE Hartley, Examiner Perreira called Applicants' representative and left a message. On the 24th, Examiner Perreira explained on the phone that the position of the Office is that the MPEP § 716.10 cited for authority by Applicants did not apply in the current case. Rather, the Office's position was that the Declaration described in § 716.10 is only able to remove a 102(e) reference when the reference is by joint inventors and the rejected claims are in an application with a sole inventor. Because in the current case, the reference is by a single author and the rejected claims are by joint inventors, the Office takes the position that the Declaration, which establishes that the relevant disclosure in the Seth reference is by the joint inventors, is not adequate.

THE DECLARATION IS EFFECTIVE TO REMOVE THE SETH REFERENCE

According to MPEP § 2136.05, a 35 U.S.C. § 102(e) rejection can be overcome by showing that the reference describes Applicant's own work. It further states that even if Applicant's work was publically disposed prior to his or her Application, Applicant's own work may not be used against him unless there is a time bar under 35 U.S.C. § 102(b). The MPEP goes on to state:

Therefore, when the unclaimed subject matter of a reference is Applicant's own invention, Applicant may overcome a *prima facie* case based on the patent...by showing that the disclosure is a description of Applicant's own previous work.

The MPEP continues:

In the situation where one application is first filed by inventor X and then later another application is filed by X and Y, it must be proven that the joint invention was made first, was thereafter described in the sole applicant's patent, and then the joint application was filed. *In re Land*, 368 F.2nd 866, 151 USPQ 621 (CCPA 1956).

Applying the rule to the current case, inventors Schmitt and Seth (X and Y) swear in the Declaration that the disclosure of the joint invention by Seth (Inventor X) in the reference is the joint inventors' own work. This stands as proof that the joint invention was made first, was thereafter described in the sole Applicant's patent, and then that the joint application was filed.

In contrast to the position apparently taken by the Office in rejecting the Declaration, it is possible for joint inventors X and Y (as in the current case) to overcome a 102(e) reference by inventor X. In *Land*, an art reference by Land was cited under 102(e) against an application by joint inventors Land and Rogers. Although the joint inventors could not overcome the sole inventor's (Land's) disclosure based on the facts, the Court acknowledged that joint inventors were entitled to prove the sole applicant's work was their own, and that such a showing would operate to remove the reference. The court summarized the analysis, stating:

In short, there are two conditions expressed in section 102(e): (1) the application for the reference patent must have been by one who is legally "another" and (2) the filing date must be "before the invention * * * by the applicant * * *." When the 102(e) reference patentee got knowledge of the applicant's invention from him, as by being associated with him, or, as here, had knowledge of the joint applicants' invention by being one of them, and thereafter describes it, he necessarily files the application after the applicant's invention date and the patent as a "reference" does not evidence that the invention, when made, was already known to others. Evidence of such a state of facts, whatever its form, must be considered. *Land*, 368 F.2d 866, 879, 151 USPQ 621, 633. *Emphasis added.*

Applicants submit that joint inventors Schmitt and Seth have proved that the disclosure of Seth '471 relied on to reject their joint claims was in fact the joint inventors' own work. According to the principle of *Land* and the clear language of 35 U.S.C. 102(e), such a showing removes the reference.

Applicants respectfully request reconsideration of the Office's position with respect to the Declaration so that it is accepted as sufficient to remove the Seth reference.

CONCLUSION

For the reasons discussed above, the Applicants believe that all of the rejected claims are patentable over the cited references and respectfully request an early Notice of Allowance. In the alternative, Applicants respectfully request an Advisory Action stating whether the remarks can be considered at this time. The Examiner is invited to telephone the undersigned if that would be helpful to resolving any issues.

Respectfully submitted,

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